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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,107	04/11/2001	Hiroshi Miyanaga	P20117	8655
7055	7590	03/07/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			CHANG, SUNRAY	
			ART UNIT	PAPER NUMBER

2121

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/832,107

Applicant(s)

MIYANAGA, HIROSHI

Examiner

Sunray Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in responsive to the paper filed on December 29th, 2004.
2. Claims 16 – 26 are presented for examination.

Claims 16 – 26 are rejected.

Claims 1 – 15 have been cancelled in December 29th, 2004 amendment.

Drawings

3. The drawings are objected to because “Transmission mail server” has been misspelled to be “Transnission mail server” in Fig. 1.

Claim Objections

4. Claims 16, and 20 – 26 are objected to because of the following informalities:

Regarding independent claims 16 and 20 – 26, the term, “the mail server” is not clearly pointed out to be either “Transmission mail server” or “Reception mail server” in Fig. 3.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by

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another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 16, 19 and 23 are rejected** under 35 U.S.C. 102(e) as being anticipated by Kiyoshi Toyoda (U.S. Patent No. 6,094,277, and referred to as Toyoda98 hereinafter).

6. **Regarding independent claims 16 and 23,**

teaches,

- An electronic mail communication apparatus transmitting an email to a destination via a mail server; [Col. 2, Lines 51 – 56]
 - a scanner configured to scan image data; [Col. 3, Lines 19 – 21, and 2, Fig. 2]
 - a memory configured to store a limit capacity of the mail server, the limit capacity indicating a maximum data amount that the mail server can store for one e-mail transmission; [Col. 4, Line 11 – 13] and
 - a controller configured to convert the image data into data for Internet transmission, to attach the converted data to the e-mail, and to transmit, to the destination, the e-mail to which the converted data is attached, via the mail server; [Col. 3, Lines 19 – 21, and 41 – 49]
 - the controller being further configured to compare the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server; [Col. 5, Lines 37 – 44]
- and

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- to notify a user of the electronic mail communication apparatus of an excess of the data amount of the e-mail to which the converted data is attached over the limit capacity of the mail server when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server. [Col. 5, Lines 37 – 44, and Col. 4, Lines 38 – 48]

7. Regarding dependent claim 19,

- a smaller of a data amount that a transmitting mail server can store and a data amount that a receiving mail server can store. [Capacity, Col. 4, Lines 10 – 13, Col. 5, Lines 40 – 44, and Fig. 1]

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 17 and 18 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Toyoda98, and in view of Kiyoshi Toyoda (U.S. Patent No. 6,778,287 and referred to as Toyoda99 hereinafter).

(Toyoda98 as set forth above generally discloses the basic inventions.)

9. **Regarding dependent claim 17,**

Toyoda98 teaches notifying a user of the electronic mail communication apparatus of an excess of the data amount of the e-mail to which the converted data is attached over the limit capacity of the mail server. [Col. 5, Lines 37 – 44, and Col. 4, Lines 38 – 48]

Toyoda98 does not teach a speaker.

Toyoda99 teaches a speaker, for the purpose of providing notifications.

It would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teaching of Toyoda98 to include "a speaker", for the purpose of providing notifications.

10. **Regarding dependent claim 18,**

Toyoda98 does not teach a display.

Toyoda99 teaches a display, for the purpose of providing notifications.

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It would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teaching of Toyoda98 to include "a display", for the purpose of providing notifications.

11. **Claims 20 and 24 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Toyoda98, and in view of Takehiro Yoshida et al. (U.S. Patent No. 5,031,179 and referred to as Yoshida hereinafter).

12. **Regarding dependent claims 20 and 24,**

Toyoda98 teaches

- An electronic mail communication apparatus transmitting an email to a destination via a mail server; [Col. 2, Lines 51 – 56]
- a scanner configured to scan image data; [Col. 3, Lines 19 – 21, and 2, Fig. 2]
- a memory configured to store a limit capacity of the mail server, the limit capacity indicating a maximum data amount that the mail server can store for one e-mail transmission; [Col. 4, Line 11 – 13] and
- a controller configured to convert the image data into data for Internet transmission, to attach the converted data to the e-mail, and to transmit, to the destination, the e-mail to which the converted data is attached, via the mail server; [Col. 3, Lines 19 – 21, and 41 – 49]
- the controller being further configured to compare the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server; [Col. 5, Lines 37 – 44]

Toyoda98 does not teach dividing the image data into a plurality of pieces when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server, to convert the divided image data into data for the Internet transmission, to attach each of the divided and converted data to an e-mail, and to transmit, to the destination, each email to which the divided and converted data is attached, via the mail server.

Yoshida teaches dividing the image data into a plurality of pieces when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server, to convert the divided image data into data for the Internet transmission, to attach each of the divided and converted data to an e-mail, and to transmit, to the destination, each email to which the divided and converted data is attached, via the mail server [Col. 6, Lines 42 – 62], for the purpose of enabling efficient data transmission.

It would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teaching of Toyoda98 to include "dividing the image data into a plurality of pieces when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server, to convert the divided image data into data for the Internet transmission, to attach each of the divided and converted data to an e-mail, and to transmit, to the destination, each email to which the divided and converted data is attached, via the mail server", for the purpose of enabling efficient data transmission.

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13. **Claims 21 and 25 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Toyoda98, and in view of Dean Schiller et al. (U.S. Patent No. 6,442,573 and referred to as Schiller hereinafter).

14. **Regarding dependent claims 21 and 25,**

Toyoda98 teaches

- An electronic mail communication apparatus transmitting an email to a destination via a mail server; [Col. 2, Lines 51 – 56]
- a scanner configured to scan image data; [Col. 3, Lines 19 – 21, and 2, Fig. 2]
- a memory configured to store a limit capacity of the mail server, the limit capacity indicating a maximum data amount that the mail server can store for one e-mail transmission; [Col. 4, Line 11 – 13] and
- a controller configured to convert the image data into data for Internet transmission, to attach the converted data to the e-mail, and to transmit, to the destination, the e-mail to which the converted data is attached, via the mail server; [Col. 3, Lines 19 – 21, and 41 – 49]
- the controller being further configured to compare the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server; [Col. 5, Lines 37 – 44]

Toyoda98 does not teach reducing the data amount of the image data by changing a resolution of the image data when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server, to convert the reduced image data into data for the Internet transmission, to attach the converted data to the e-mail, and to transmit, to the

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destination, the e-mail to which the converted data is attached, via the mail server, for the purpose of preventing large files from consuming resources on the system.

Schiller teaches reducing the data amount of the image data by changing a resolution of the image data when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server, to convert the reduced image data into data for the Internet transmission, to attach the converted data to the e-mail, and to transmit, to the destination, the e-mail to which the converted data is attached, via the mail server [Col. 26, Line 18 – Col. 27, Line 24, and Fig. 6], for the purpose of preventing large files from consuming resources on the system.

It would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teaching of Toyoda98 to include "reducing the data amount of the image data by changing a resolution of the image data when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the mail server, to convert the reduced image data into data for the Internet transmission, to attach the converted data to the e-mail, and to transmit, to the destination, the e-mail to which the converted data is attached, via the mail server, for the purpose of preventing large files from consuming resources on the system", for the purpose of preventing large files from consuming resources on the system.

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15. **Claims 22 and 26 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Toyoda98, and in view of Neil Raymond Joffe (U.S. Patent No. 6,671,061 and referred to as Joffe hereinafter).

16. **Regarding dependent claims 22 and 26,**

Toyoda98 teaches

- An electronic mail communication apparatus transmitting an email to a destination via a mail server; [Col. 2, Lines 51 – 56]
- a scanner configured to scan image data; [Col. 3, Lines 19 – 21, and 2, Fig. 2]
- a memory configured to store a limit capacity of the mail server, the limit capacity indicating a maximum data amount that the mail server can store for one e-mail transmission; [Col. 4, Line 11 – 13] and
- a controller configured to convert the image data into data for Internet transmission, to attach the converted data to the e-mail, and to transmit, to the destination, the e-mail to which the converted data is attached, via the mail server; [Col. 3, Lines 19 – 21, and 41 – 49]
- the controller being further configured to compare the data amount of the e-mail to which the converted data is attached with the limit capacity of the mail server; [Col. 5, Lines 37 – 44]

Toyoda98 does not teach selecting another mail server that has a capacity to store the image data when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the designated mail server, and to transmit, to the destination, the e-mail to

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which the converted data is attached via the another mail server, based on the IP address corresponding to the another mail server.

Joffe teaches selecting another mail server that has a capacity to store the image data when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the designated mail server, and to transmit, to the destination, the e-mail to which the converted data is attached via the another mail server, based on the IP address corresponding to the another mail server [Col. 5, Line 60 – Col. 6, Line 5], for the purpose of efficiently broadcasting of fax messages to multiple fax recipients in an inexpensive manner.

It would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teaching of Toyoda98 to include "selecting another mail server that has a capacity to store the image data when the data amount of the e-mail to which the converted data is attached exceeds the limit capacity of the designated mail server, and to transmit, to the destination, the e-mail to which the converted data is attached via the another mail server, based on the IP address corresponding to the another mail server", for the purpose of efficiently broadcasting of fax messages to multiple fax recipients in an inexpensive manner.

Response to Amendment

17. Applicant's arguments regarding "a memory configured to store a limit capacity of the mail server", the term "the mail server" has not been clearly pointed out which mail server it should be. Regarding Figure 3, there are two mail servers, "transmission mail server" and

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“reception mail server”. Since there is an ambiguity in the language, the claim has been interpreted broadly consistent with applicant’s disclosure.

18. Applicant’s arguments regarding “a controller” in claim 1, does not specify whether the controller is in the transmitting or receiving mail server. Accordingly, applicant’s claims have been interpreted broadly and are thus met by Toyoda98 and Toyoda99 as set forth above.

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunray Chang whose telephone number is (571) 272-3682. The examiner can normally be reached on M-F 7:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on (571) 272-3687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-746-3506.

Sunray Chang
Patent Examiner
Group Art Unit 2121
Technology Center 2100
U.S. Patent and Trademark Office



Anthony Knight
Supervisory Patent Examiner
Group 3600

March 3, 2005